



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,975	03/23/2001	Jayme Matthew Fishman	13230-101	7347
26486	7590	03/08/2004	EXAMINER	
PERKINS, SMITH & COHEN LLP			JACKSON, JENISE E	
ONE BEACON STREET			ART UNIT	PAPER NUMBER
30TH FLOOR			2131	
BOSTON, MA 02108			DATE MAILED: 03/08/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/816,975	FISHMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jenise E Jackson	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 10-17 rejected under 35 U.S.C. 102(b) as being anticipated by Maes.
3. As per claim 1, Maes et al. discloses a system for authentication of a party in a transaction conducted over a communication network(see col. 7, lines 57-65), a wallet-sized storage medium(i.e. smartcard)(see col. 14, lines 21-22) containing information uniquely associated with the party read by a conventional computer operated by the party as part of the transaction; and an authentication server remote from the computer that receives the stored information(i.e. digital signature) and a personal code(i.e. PIN) entered by the party(see col. 8, lines 25-27) from the conventional computer as part of the transaction and authenticates the party to the transaction upon matching of the stored information with the personal code based upon information in a preexisting database(see col. 14, lines 17-46).
4. As per claim 2, Maes et al. discloses wherein the stored information is transmitted from the conventional computer to the authentication server via a computer of a second party(i.e. ATM or POS terminal)(see col. 14, lines 17-45).
5. As per claim 3, Maes et al. discloses wherein the personal code is transmitted from the conventional computer to the authentication server via the computer of the second party(see col. 14, lines 21-26).

Art Unit: 2131

6. As per claim 4, wherein the stored information are one-use tokens.
7. As per claim 5, Maes et al. discloses wherein the stored information is a digital certificate(see col. 14, lines 21-24).
8. As per claim 6, Maes et al. discloses wherein the personal information is a password(see col. 14, lines 21-24).
9. As per claim 7, Maes et al. discloses wherein the wallet-sized storage medium is a truncated CD(i.e. smartcard)(see col. 14, lines 22).
10. As per claim 10, Maes et al. discloses copying to a document generated by the application information from a wallet-sized storage medium read by the conventional, the copied information uniquely associated with a user interacting with the application(see col. 3, lines 17-37). Further, as per claim 10, limitations have already been addressed(see claim 1).
11. As per claim 11, limitations have already been addressed(see claim 1).
12. As per claim 12, limitations have already been addressed(see claim 2).
13. As per claim 13, limitations have already been addressed(see claim 3).
14. As per claim 14, limitations have already been addressed(see claim 4).
15. As per claim 15, limitations have already been addressed(see claim 5).
16. As per claim 16, limitations have already been addressed(see claim 6).
17. As per claim 17, limitations have already been addressed(see claim 7).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2131

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. in view of Lambert et al.

20. As per claim 8, Maes does not disclose wherein the stored information includes at least two groups, each of which, upon matching the personal code by the authentication server, authenticates the transaction for a different level of security or authority than authentication thorough the second group; Lambert however discloses wherein the stored information includes at least two groups, each of which, upon matching the personal code by the authentication server, authenticates the transaction for a different level of security or authority than authentication thorough the second group(see col. 2, lines 2-13, 30-33).

21. It would have been obvious to one of ordinary skill in the art to combine Maes with Lambert, because Lambert discloses that problem arises when seeking to control access to data where a number of different users are required to be allowed to access different sets of data such as an ATM(see col. 1, lines 11-21, 48-50). Lambert discloses that a conventional approach to this problem included having a table lookup process of the user, however, Lambert discloses that lookup tables are vulnerable to breaches of security(see col. 1, lines 58-67 of Lambert), thus in Lambert's system the lookup data is stored on the smartcard.

22. As per claim 9, Lambert discloses wherein the user has at least two personal codes that may be matched to the stored information, each of which, upon matching with the personal code by the authentication server, authenticates the transaction for a different level of security or

authority than authentication thorough the second personal code(see col. 2, lines 2-13, 30-33).

Also, as per claim 9, same motivation applies(see claim 8).

23. As per claim 18, limitations have already been addressed(see claim 8).
24. As per claim 19, limitations have already been addressed(see claim 9).

#### ***Double Patenting***

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 1-3 and 11 of 09/816975 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, and 9 of copending Application No. 10/132438. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

27. As per claim 1 of 09/816975, and claim 1 of 10/132438, 10/132438 claims the storage medium integrally including additional information uniquely associated with the party. It would have been obvious to include this limitation in 09/816975 the motivation is that the storage

Art Unit: 2131

medium can include additional information such as the stored information and personal code of the party, because the storage medium is used in order to perform a transaction, and thus the party is authenticated based on this information. Further, as per claim 1 of 09/816975 and 10/132438 recite same limitations.

28. As per claim 2, of 09/816975, and claim 2 of 10/132438 recite same limitations.
29. As per claim 3, of 09/816975, and claim 2 of 10/132438 recite same limitations.
30. As per claim 11, of 09/816975, and claim 11 of 10/132438, 10/132438 claims storage medium integrally including additional information uniquely associated with the party, 09/816975 claims prompting for and receiving entry by the conventional computer of personal code of the party. It would have been obvious to include the limitation above(10/132438), because the storage medium is used in order to perform a transaction, and thus the party is authenticated based on this information.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Shiekh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



\*\*\*



AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100